

REMARKS

Claims 50-52, 54-69, and 71-100 are pending in the present application.

Claims 50-51, 54-56, 58-59, 61, 65-68, 71-73, 75-76, 78, 82, 84, and 92 stand rejected under 35 U.S.C. 102(b) for anticipation by U.S. Patent No. 4,782,342 to Walton. Claims 84, 86, 88, 92, 94, and 96 stand rejected under 35 U.S.C. 103(a) for obviousness over Walton in view of U.S. Patent No. 5,801,466 to Odagiri. Claims 52, 57, 60, 62-64, 69, 74, 77, 79-81, and 85 stand rejected under 35 U.S.C. 103(a) for obviousness over Walton in view of U.S. Patent No. 5,493,437 to Lebby et al. Claims 89 and 97 stand rejected under 35 U.S.C. 103(a) for obviousness over Walton in view of Lebby et al. and further in view of U.S. Patent No. 6,104,333 to Wood, Jr. Claims 90 and 98 stand rejected under 35 U.S.C. 103(a) for obviousness over Walton in view of Lebby et al. and further in view of Odagiri. Claims 83, 87, 91, 93, 95, and 99-100 stand rejected under 35 U.S.C. 103(a) for obviousness over Walton in view of Wood, Jr.

Applicant respectfully traverses the rejections and urges allowance of the present application.

Applicant respectfully asserts that the Office Action clearly fails the regulatory mandate of 37 C.F.R. 1.104(b) that "the examiner's action will be complete as to all matters" and 37 C.F.R. 1.104(c)(2) requiring that "the pertinence of each reference, if not apparent, must be clearly explained." At least for these reasons, Applicant requests a new non-final Office Action completely addressing all matters currently of record if the application is not allowed.

In the previous Office Action response dated October 21, 2002, Applicant argued the inappropriateness of utilizing the teachings of Wood in support of any prior art rejection

of the claims. Further, this exact issue was discussed by a telephone interview of October 7, 2002. The Interview Summary mailed by the Office on October 10, 2002 indicates this issue was discussed. However, the substance of the interview is erroneous. During the interview, the undersigned referred the Examiner to 35 U.S.C. 103(c), and indicated that Wood only qualifies as art under 102(e) and is subject to an assignment to the same entity as the subject application. Accordingly, Wood does not qualify as prior art.

Applicant's response dated October 21, 2002 presented the following:

35 U.S.C. '103(c) provides that subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), (g) of '102, shall not preclude patentability under '103 where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. The Wood reference and the claimed invention were subject to an obligation of assignment to the same entity and the Wood reference qualifies as prior art under subsection (e) of '102. Accordingly, the Wood reference has been improperly utilized in support of the obviousness rejection. Applicant respectfully requests withdrawal of all obviousness rejections over Wood and allowance of such claims in the next Action.

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validity
of 103(c)
argument

The Response to Amendment section of the present Office Action fails to mention or address Applicant's previously-presented argument under 103(c). Further, Wood has now again been improperly relied upon in rejections of Applicant's claims. Pursuant to 37 C.F.R. 1.104(b) the subject Action is clearly "not complete as to all matters" inasmuch as Applicant's 103(c) argument has not been addressed and Wood has once again been relied upon in support of the rejection of Applicant's claims.

Accordingly, Applicant respectfully requests issuance of a **non-final Office Action** to correct the deficiencies of the subject Action if the application is not allowed.

M.P.E.P. §706.07 (8th ed.) states that “the examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.” (Emphasis added.) Clearly, it is possible for the Examiner either to develop a clear issue between the Applicant or to allow the claims if the Examiner will correct the noted errors, consider all arguments, and respond to all arguments. Presently, the record for appeal is poor due to the deficiencies of the current and prior Office Actions.

M.P.E.P. §706.07 further states that “...present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application.” According to M.P.E.P. §706.07, final rejections “must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal” and “should include a rebuttal of any arguments raised in the applicant’s reply.” (Emphasis added). Applicant will be deprived of such an opportunity if the next Action is final.

Further, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicants respectfully request clarification of the

rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) as discussed in more detail below.

Accordingly, the M.P.E.P. and C.F.R. both provide Applicant is entitled to a **non-final Action** if the application is not allowed.

Turning to the subject rejections of the present Action, the Examiner states Walton discloses a radio frequency identification device as recited in claim 50 by relying upon teachings of col. 6 of Walton as set forth on page 2 of the Action. Pages 2 and 4 of the Action state Walton discloses a radio frequency identifier circuit. Applicants have electronically searched and have failed to uncover any "radio frequency identifier" circuit as alleged in the Action. Walton is devoid of any RFID or radio frequency identification device circuitry teachings as claimed, and claim 50 is allowable for at least this reason. Applicant submitted RFID information in an Information Disclosure Statement filed with the previous response. The reference has not been initialed on the submitted Form PTO-1449 as discussed below. The submitted materials illustrate the specific nature of radio frequency identification devices (RFIDs) and the deficiencies of Walton. Claim 50 is allowable.

The claims which depend from independent claim 50 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, on page 5 of the Action, it is stated that subject matters in claim 51 are disclosed in claim 82, and therefore, rejections of subject matters in claims 50, 53, 66-68 are met by references and associated arguments applied to rejections of claim 82. Initially, Applicant disagrees with the position that subject matters in claim 51 are disclosed in claim

82. The PTO and Federal Circuit provide that §102 anticipation requires that *each and every element* of the claimed invention be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Any alleged "disclosure" of claim 82 is irrelevant to a 102 inquiry of claim 51. Instead, and in accordance with the C.F.R., the Office Action is required to identify teachings in the prior art reference which allegedly disclose limitations of claim 51. None are provided in the Office Action. Further, claim 82 does not include limitations of claim 51 and any analysis of claim 82 is irrelevant to claim 51. Claim 51 recites ***an encapsulant which contacts the communication circuitry***. Contrary to the C.F.R., the Office Action fails to identify any teachings in the art which allegedly disclose the claimed limitations of claim 51. Walton fails to disclose or suggest limitations of claim 51 and claim 51 is allowable for at least this reason.

The reliance upon Wood in support of the rejection of claim 83 is improper for at least the above-mentioned reasons. Claim 83 is allowable.

On page 6 of the Action, it is stated that subject matters of claim 54 are disclosed in claim 59. Applicant disagrees inasmuch as claim 54 recites a substrate and an encapsulant. Claims 59, 61 do not explicitly define a substrate. Nonetheless, the claimed subject matter of claims 59, 61 is irrelevant to the prior art analysis of claim 54 as mentioned above. Walton fails to disclose or suggest the claimed *substrate* in combination with the *encapsulant*. The Office Action fails to identify any Walton teachings which allegedly disclose the claimed limitations but rather inappropriately relies upon other pending claims. Col. 6, lines 44-53 of Walton merely provide an assembly encapsulated within a plastic rectangular bar 610 with absolutely no substrate teachings. Limitations of

claim 54 are not shown nor suggested and claim 54 is allowable.

The claims which depend from independent claim 54 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 84 recites a battery coupled with communication circuitry. On page 6 of the Action, the Examiner refers to the disclosure of claim 82 in support of the rejection of claim 84. The disclosure of claim 82 is irrelevant with respect to any prior art analysis of claim 84. Claim 84 includes limitations not explicitly defined in claim 82. The Office Action fails to identify any teachings of Walton in support of the rejection of claim 84,

as required in a proper 102 rejection, and the 102 rejection of claim 84 is improper for at least this reason. With respect to the obviousness rejection of claim 84, there is no motivation to combine the teachings of Odagiri with the teachings of Walton. As recognized by the Office Action on page 4, Walton at col. 6, lines 1-53 provides a device having identifier circuit 212 energized by the reader. One would not be motivated to look to Odagiri for meaningful teachings with respect to Walton inasmuch as Walton already provides the teachings (energized power source from the reader) for which Odagiri is presented. The alleged motivation is redundant and therefore lacking and the rejection under 103 is improper for at least this reason.

Claim 85 recites communication circuitry configured to implement backscatter communications. The Examiner relies upon teachings of Walton and Lebby in support of the rejection of claim 85. However, as indicated on page 10 of the Action, Walton and Lebby do not disclose or suggest backscatter communications. Limitations of claim 85 are not shown nor suggested by the prior art and claim 85 is allowable for at least this reason.

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#3
Walton fails to disclose or suggest an encapsulant configured to encapsulate and contact at least a portion of the communication circuitry as recited in claim 59. Claim 59 recites limitations not shown nor suggested in the art and claim 59 is allowable for at least this reason.

5 The claims which depend from independent claim 59 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

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#2
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Claim 62 recites a radio frequency identification device. Walton fails to disclose or suggest any RFID or radio frequency identification device teachings. Claim 62 is allowable for at least this reason.

The claims which depend from independent claim 62 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

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#4
Walton fails to disclose or suggest a substrate and an encapsulant as defined in claim 65. Claim 65 is allowable for at least this reason.

Walton fails to disclose or suggest the radio frequency identification device circuitry of claim 66. Claim 66 is allowable for at least this reason.

The claims which depend from independent claim 66 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

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Walton fails to disclose or suggest a substrate or the encapsulating at least portions of the support surface of the substrate as defined in claim 71. Claim 71 is allowable for at least this reason.

all
The claims which depend from independent claim 71 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

✓ 4
ser #7
Walton fails to disclose or suggest encapsulating at least a portion of communication circuitry with an encapsulant which contacts at least the encapsulated portion of the communication circuitry as recited in claim 76. Claim 76 is allowable.

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The claims which depend from independent claim 76 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

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ser #2
Walton fails to disclose or suggest providing radio frequency identification device circuitry as defined in claim 79. Claim 79 is allowable for at least this reason.

The claims which depend from independent claim 79 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

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ser #2
Walton fails to disclose or suggest providing radio frequency identification device circuitry as defined in claim 82. Claim 82 is in condition for allowance.

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The claims which depend from independent claim 82 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 99, Wood does not qualify as prior art. Walton fails to disclose or suggest backscatter communications as recognized in the Office Action. Backscatter communication limitations of claim 99 are not shown nor suggested and claim 99 is allowable for at least this reason.

new
4/20/03
Referring to claim 100, the prior art fails to disclose or suggest backscatter communication circuitry in combination with the other claimed limitations. Claim 100 is allowable for at least this reason.

The Office Action fails to identify teachings of the prior art which allegedly disclose or suggest numerous limitations of Applicant's claims contrary to the C.F.R. and M.P.E.P. Further, the limitations are not shown nor suggested by the prior art and Applicant requests a non-final action if any claim is not found to be allowable in the next Action.

Applicant submitted an Information Disclosure Statement on October 2, 2002.

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Applicant has not received an initialed PTO-1449 indicating the reference has been considered by the Examiner. Applicant encloses a copy of the 1449 and respectfully requests initialization of the reference thereon and return of the initialed form to Applicant.

Applicant respectfully requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: 5/2/03

By: 

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